

18 Merger

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1. Introduction

Section 199(b)(ii) of Trade Marks Act 2002 allows for the making of regulations to provide for the merging of separate trade mark applications or registrations.

Regulations 54-56 of the Trade Marks Regulations 2003 (“the Regulations”) prescribe the requirements for the merger of trade mark applications or registrations.

2. Merger

A trade mark applicant may apply to merge two or more trade mark applications and a trade mark registration owner may apply to merge two or more trade mark registrations into one application or registration respectively.

For example, an applicant may wish to merge separate applications that had been divided at an earlier date in order to overcome a concern raised in a Compliance Report or an opposition proceeding.

An application for merger may be made be filed at any time.

3. Filing an application for merger

An application for the merger of a trade mark application or registration must be made in writing¹. The Commissioner will accept any manner of written communication that contains all the requirements for filing the application under the Regulations.

IPONZ has provided an example of a merger application form to assist with filing an [application for a merger](#).

There is no fee for filing an application to merge separate trade mark applications or registrations.

¹ Regulation 55(a) of the Trade Marks Regulation 2003.

3.1 Filing Locations

²An application may be made through our [online correspondence facility](#), which is available everyday, 24 hours a day.

Alternatively, a paper application may be filed between 8.30 am and 5 pm, Monday to Friday (not including public holidays). For our postal details please see [contact us](#).

Footnote

² Regulation 55(a) of the Trade Marks Regulation 2003.

3.2 Filing Receipts

Filing receipts are used as a means of confirming receipt for a variety of documents sent to IPONZ. All copies of filing receipts received are date stamped.

IPONZ date-stamps up to two filing receipts proffered with date-critical documents from agents and returns a filing receipt for each document to the sender.

4. Minimum filing requirements

An application for the merger of separate trade mark applications must be made by the trade mark applicant³.

An application for the merger of separate trade mark registrations must be made by the owner of the registered trade marks⁴.

An application for merger must contain the following information⁵:

- The name of the applicant for merger;
 - Their address for service;
 - If the applicant has an agent, the agent's name; and
 - The numbers of all applications or registrations to be merged.
-

Footnote

³ Regulation 54(1) of the Trade Marks Regulations 2003.

⁴ Regulation 54(1) of the Trade Marks Regulations 2003.

⁵ Regulation 56 of the Trade Marks Regulations 2003.

5. Examination

Where a person applies for merger of trade mark applications or registrations, the Commissioner must be satisfied that the request to merge the separate trade mark applications or registrations:

- Are for the same mark or series of marks;⁶
- Have the same filing date and convention priority date, if any;⁷
- Have the same status;⁸
- Are in the name of the same applicant or owner;⁹ and
- Are classified according to the same edition of the Nice Classification.¹⁰

These requirements are discussed below. An application for a merger will not be accepted if the trade mark application or registration has been refused, withdrawn or abandoned is no longer “active”.

Footnotes

6 Regulation 54(2)(a) of the Trade Marks Regulations 2003

7 Regulation 54(2)(b) of the Trade Marks Regulations 2003

8 Regulation 54(2)(c) of the Trade Marks Regulations 2003

9 Regulation 54(2)(d) of the Trade Marks Regulations 2003

10 Regulation 54(2)(e) of the Trade Marks Regulations 2003

5.1 Mark

An application for merger of separate trade mark applications or registrations will not be accepted where the marks are not identical¹¹. This includes the situation where the different trade mark applications or registrations would constitute a series but are not identical.

Footnote

¹¹ Regulation 54(2)(e) of the Trade Marks Regulations 2003

5.2 Filing and convention dates

An application for merger of separate trade mark applications or registrations will not be accepted where the marks have a different filing date or convention priority date¹².

An application for merger will not be accepted where one application or registration claims a multiple or partial convention priority and the other application or registration does not.

Footnote

¹² Regulation 54(2)(b) of the Trade Marks Regulations 2003.

5.3 Status

An application for merger of separate trade mark applications or registrations will not be accepted where the marks do not have the same status¹³. For example, where the marks are under examination then all the marks must be at examination status, namely, status 50. Where the marks are registered all the subject marks must at the same registered status, namely status 100.

Footnote

¹³ Regulation 54(2)(c) of the Trade Marks Regulations 2003.

5.4 Name of applicant or owner

An application for merger of separate trade mark applications or registrations will not be accepted where the name of the applicant for the merger is not exactly the same as the respective trade mark applicant or trade mark registration owner.¹⁴

Footnote

¹⁴ Regulation 54(2)(d) of the Trade Marks Regulations 2003.

5.5 Classification

An application for merger of separate trade mark applications or registrations will not be accepted where the marks are not classified according to the same edition of the Nice Classification or Schedule to the Trade Marks Regulations 1954.¹⁵

Footnote

¹⁵ Regulation 55(a) of the Trade Marks Regulation 2003.

6. The merger process

Where an application for merger is accepted, the separate trade mark applications or registrations will be merged into the header file. The header file is the lowest number of the trade mark application or registration. The header file will show the current status of the applications or registrations, for example, “examination” or “registered”.

Each application or registration merged into a header file will appear on the IPONZ database as “merged” in the “current status” field. The relevant numbers of the header file and the merged files will appear on the IPONZ database in the “related trade marks” field of both the merged files and the header file.

7. Rejection

Where the details of an application for merger are not in order, the application will be rejected.

Where the Commissioner proposes to reject an application for the merger of separate trade mark applications or registrations, the applicant will be sent a Notice of Rejection of Merger, advising that the application to merge is rejected. The Notice will state the grounds on which the Commissioner rejects the application to merge the trade marks.

Appendix 1: Application for merger

[Appendix 1: Application for merger \[13 kB PDF\]](#)